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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/175,905 | 10/20/1998 | DENNIS W. HICKS | 0142-0317P | 7486 |
| 2292 | 7590 | 09/14/2005 | EXAMINER | |
| BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | BASHORE, WILLIAM L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2176 | |

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/175,905

Applicant(s)

HICKS ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims:

Claims pending in the application are 1-6,8-16,29-34,39-44,72,101-107,144-150,152-160,168,173-178,183-188,216,245-251 and 288-306.

Continuation of Disposition of Claims:

Claims rejected are 1-6,8-16,29-34,39-44,72,101-107,144-150,152-160,168,173-178,183-188,216,245-251 and 288-306.

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DETAILED ACTION

1. This action is responsive to communications: amendment, filed 5/9/2005, and supplemental amendment filed 7/20/2005, to the original application filed 10/20/1998, with provisional filing date of 10/22/1997.

3. Claims 1-6,8-16,29-34,39-44,72,101-107,144-150,152-160,168,173-178,183-188,216,245-251 and 288-306 pending. Various claims have been amended, added and canceled as indicated in Applicant's submitted amendments (see above). Claims 1, 145 are independent claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 8-16, 29-34, 39-44, 72, 101-107, 144-150, 152-160, 168, 173-178, 183-188, 216, 245-251 and 288-306 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guck, U.S. Patent No. 5,911,776 issued June 1999, in view of Shaw et al. (hereinafter Shaw), U.S. Patent No. 5,881,213 issued March 1999, and further in view of Suzuki et al. (hereinafter Suzuki), U.S. Patent No. 6,213,652 issued April 2001, and further in view of Goertz et al. (hereinafter Goertz), U.S. Patent No. 6,173,295 issued January 2001.

In regard to independent claim 1, Guck teaches automatic format conversion of a document into a specific device compatible document via streaming (from one computer to another), and a shadow file on a central computer dedicated to a particular output format. (Guck Abstract, column 4 lines 40-55, column 5 lines

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19-24, column 8 lines 55-67; compare with claim 1 “*a system for delivering documents across a network.... which system comprises:*”).

Guck does not specifically teach “an integrated solution”. However, Suzuki teaches a job scheduling device which centralizes all aspects of document translation, etc. into a print job, which is a form of integrated solution (Suzuki Abstract; compare with claim 1 “*...an integrated solution...*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of centralized integrated “jobs” for complete processing.

Guck does not specifically teach document translation of an input stream into a stream having an output device independent format at client side, said stream sent to a server computer. However, Shaw teaches print jobs (typically originating from an inputted authored document via an editor) spooled in a device-independent format (enhanced metafile format) at a workstation, to eventually be sent (i.e. a data stream) over a network to a network print “server” to be eventually printed on different printers accordingly (Shaw Abstract, Figure 1A, 8, column 1 lines 41-56; compare with claim 1 “*a document generator at a client’s side....independent format data stream*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow Shaw to output its device independent stream to a server computer (such as Guck’s server), providing Guck the benefit of a device independent “standard base” format for translating into device specific formats to servers (i.e. a FAX printer – Guck Figure 1).

Guck teaches transmitted data in the form of electronic mail intended for a mail user (i.e. e-mail, Guck Figure 1 item 30). Guck does not specifically disclose archival data within the same data (two disparate presentations). However, since it was well known at the time of the invention that received e-mails are typically archived within an e-mail client, it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret transmitted data as both electronic e-mail data and as archival data, providing the benefit of archived e-mail for research purposes, etc.

Guck teaches translation of a received authored base document file into specific formats (using shadow files) so as to be tailored and transmitted to specific devices, accordingly (i.e. FAX printers, etc.) (Guck Abstract, column 4 lines 40-55, column 5 lines 19-24, column 8 lines 55-67, Figure 1A; compare with claim 1

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“a computer configured to receive the device independent format data stream...output devices available to the computer”, and “the computer further being programmed to translate....output device.”).

Guck does not specifically teach selecting a “best output device” according to compatible features, etc. However, Goertz teaches a print server whereby a decision is made by said server regarding selection of an appropriate printer able (i.e. best able) to handle a job request (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claim 1 “... *best output device*...”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goertz to Guck, providing Guck a way to incorporate optimum selections of diverse printer types to accommodate specialized document requirements if/when necessary.

In regard to dependent claim 2, Guck does not specifically teach a job ticket etc. However, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes, including document data (Suzuki column 45 lines 5-27). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of centralized integrated “jobs” for complete processing.

In regard to dependent claims 3-4, Guck does not specifically teach an “affinity value” for calculating a best output device. However, Goertz teaches appropriate selection from a set of diverse printers in order to process a print job, which is a form of comparison/decision making, and which incorporates basic numerical comparison at a coding algorithm level (algorithmic coding decisions are quantified at some level – i.e. Boolean TRUE/FALSE, etc.). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goertz to Guck, providing Guck the advantage of choosing the best printer to handle a special job. (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claims 3-4).

In regard to dependent claims 5-6, 8, Guck does not specifically teach assigning a job to each printer. However, Suzuki teaches a printer job assigned to each printer (Suzuki column 48 lines 60-67). It would have

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been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of multiple jobs for diverse printers.

In regard to dependent claims 9-12, Guck does not specifically teach an “affinity value” for calculating a best output device. However, Goertz teaches appropriate selection from a set of diverse printers in order to process a print job, which is a form of comparison/decision making, and which incorporates basic numerical comparison at a coding algorithm level (algorithmic coding decisions are quantified – i.e. Boolean TRUE/FALSE, etc.). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goertz to Guck, providing Guck the advantage of choosing the best printer to handle a special job. (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32).

In regard to dependent claims 13-16, Guck does not specifically teach assigning a job to each printer in a network. However, Suzuki teaches a printer job assigned to each printer in a multiple printer network (Suzuki column 48 lines 60-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of multiple jobs for diverse printers.

In regard to dependent claims 29-34, Guck does not specifically teach various elements, etc.. However, Suzuki teaches a job ticket comprising various elements (i.e. printer name, output-bin-name) to be transmitted to a printer (Suzuki column 45 lines 5-27). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of jobs with specific customized instructions for diverse printers.

In regard to dependent claims 39-44, 72, Guck does not specifically teach a separate device, etc.. However, Suzuki teaches a separate system comprising a print processor, a job accepting means, a queuing means, an output means, a converting means, and a conversion control means (Suzuki column 10 lines 19-37). It

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would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of jobs with separate and specific areas for diverse printers.

In regard to dependent claims 101-107, 144, Guck does not specifically teach embedding data etc.. However, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes (Suzuki column 45 lines 5-27; compare with claims 73-144). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of centralized integrated “jobs” for complete processing.

In regard to independent claim 145, claim 145 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Guck does not specifically teach a client side document generator configured to selectively translate and output an output device independent format. However, Shaw teaches providing an option to a user asking if said user wants jobs printed, etc. (Shaw Figure 7 item 75), therefore teaching a user (selectively) initiating print jobs (using Shaw’s system of translating and outputting accordingly) (compare with claim 145 “...*to selectively translate*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Shaw to Guck, providing Guck the benefit of user selection, so as giving a user the advantage of selective printing.

In regard to dependent claims 146-150, 152-160, 168, 173-178, 183-188, 216, 245-251, 288, said claims incorporate substantially similar subject matter as claimed in claims 1-6, 8-16, 29-34, 39-44, 72, 101-107, 144, respectively, and are rejected along the same rationale.

In regard to dependent claims 289, 290-306, Guck teaches a computer at a server site (Guck Figure 1 item 50). Guck does not specifically teach document translation of an input stream into a stream having an

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output device independent format stream sent to a server computer. However, Shaw teaches print jobs (typically originating from an inputted authored document via an editor) spooled in a device-independent format (enhanced metafile format) at a workstation, to eventually be sent (i.e. a data stream) over a network to a network print “server” to be eventually printed on different printers accordingly (Shaw Abstract, Figure 1A, 8, column 1 lines 41-56). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow Shaw to output its device independent stream to a server computer (such as Guck's server), providing Guck the benefit of a device independent “standard base” format for translating into device specific formats to servers (i.e. a FAX printer – Guck Figure 1).

Response to Arguments

6. Applicant's arguments filed 5/9/2005 have been fully and carefully considered but they are not persuasive.

Applicant argues that the cited art of record does not teach embedding data into a stream indicative of two disparate output presentations. It is respectfully noted that since it was well known that e-mail clients both display and archive accordingly, Guck's email data can be considered as combining both e-mail and archival data (an e-mail client such as Netscape archives and displays an e-mail at substantially the same time, new mail can arrive (archive) without being displayed, etc.).

Applicant argues that none of the cited references of record teach an “integrated solution” because of the alleged lack of discovery of such a problem within the art. It is respectfully noted that, along with the rejection of record, the skilled artisan is aware of many disparate output devices tailored to various media accordingly. It is also noted that providing integrated solutions to deal with the inconvenience of all these devices is well known, as evidenced by combining (bundling) Netscape with a browser, E-mail client, and Web editor, etc. Other examples include a combination FAX, scanner, photocopier, all in one unit etc., and the integration of FAX and Web browser capability within Microsoft Windows.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER

September 11, 2005